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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,537	02/05/2002	James Dennis Wilson		1329

7590  
James Dennis Wilson  
106 N. Revere Rd.  
Akron, OH 44333

11/14/2008

EXAMINER
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BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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11/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/071,537	<b>Applicant(s)</b> WILSON ET AL.	
	<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

This office action is responsive to papers filed on 7/9/2008.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**Regarding claims 1 and 9**, these claims recite the limitation "past shopping behavior metrics for each product class as derived from past incentives redeemed, past incentives refused, and a plurality of items first scanned within a product class". Lacking from the specification is a recitation directed towards selecting incentives based on past incentives refused.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**2. Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 1 and 9, these claims recite the limitation "a plurality of items first scanned". This is unclear. It is possible for one item to be the first item scanned within a plurality of items. It is unclear how multiple items can be "first" scanned. It is further unclear as to how many items may be scanned and still be considered to be "first".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 1-3, 5, 7-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211), and further in view of Christensen (U.S. Patent No. 5,710,886).**

Regarding claims 1, 2, 9, and 10, Deaton teaches delivering shopping incentives individually customized to influence each customer I(Column 4, Lines 50-54) in which the incentives are generated by a plurality of independently competing manufacturer controlled dynamic offer engines (Column 4, Lines 1-6, Figure 1,

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Reference 16, and Column 10, Lines 43-47) that customize each incentive to meet manufacturer objectives including market share (Column 4, Lines 45-49, Column 2, Lines 41-47, and Column 9, Lines 24-30). A manufacturer can't apply a marketing campaign for which funds are not available, and thus funding (budget) is inherently an internal concern for a company. Deaton determines the incentives based on current purchases (scanned at a point of sale) (Column 4, Lines 50-54 and Column 9, Lines 37-38) and customer past purchase history (Column 4, Lines 50-54). Incentives based on current purchases take into account all products, regardless of their order of scanning, and thus reads on items that are "first" scanned or "last" scanned.

Deaton does not appear to specify a wireless scanning device. Sloane teaches a wireless device with a UPC bar code scanner used by the shopper to scan product bar codes in a store (Abstract). The device uses the bar codes scanned, along with consumer purchase history (shopper information) to determine an incentive for the user (Abstract). The incentive offered to the user could be a promotion for the product scanned or a promotion for other competitive products (this is an example of competitive incentive offer engines) (Column 3, Lines 16-28). The user is able to select which promotional offers to be redeemed (Column 3, Lines 16-28). The wireless device can communicate the redeemed incentives to a point of sale (Column 3, Lines 48-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to give the consumer a portable device for discount offers instead of supplying the offers at the point of sale when the customer is already checking out.

While Deaton teaches informing the manufacturers of which coupons were redeemed (Column 4, Lines 15-19 and 37-40), neither Deaton nor Sloane appear to specify targeting incentives based on past incentives redeemed and past incentives refused. Christensen teaches a method of distributing coupons in which selecting the coupons is based on which coupons have been used in the past (past incentive redeemed) and which coupons have not been used (since the coupons were sent to the user and never redeemed, this equates to the a past incentive that was refused by the user) (Column 11, Lines 4-12). While Deaton and Sloane do not appear to specify using these specific methods of targeting, one of ordinary skill would have recognized that applying these old and well known targeting techniques (using information communicated in to the manufacturers in Deaton) would have yielded predictable results and resulted in an improved (and more targeted) incentive system.

**Regarding claims 3, 5, 7, 11-13, 15, and 16**, Deaton teaches Internet connection, wireless connections, and dedicated lines (Column 9, Lines 15-23). Sloane teaches communication over radio frequency and cellular communications (Column 7, Lines 49-57).

**Regarding claim 8**, the circuitry contained within the device of Sloane is the same type of circuitry that could be found in a GPS, and therefore, Sloane's wireless device comprises GPS circuitry.

4. **Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No.**

**5,918,211) and further in view of Christensen (U.S. Patent No. 5,710,886) and yet further in view of Anttila (U.S Patent No. 6,862,575).**

**Regarding claims 6 and 14**, Deaton, Sloane, and Christensen do not appear to specify a wireless device as generating a bar code to be scanned by a point of sale. Anttila teaches a wireless device that generates a scannable bar code (Column 5, Lines 6-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow Sloane's device to generate bar codes to promote ease of use.

### ***Response to Arguments***

5. Applicant argues that claim 4, as originally filed, contains the information rejected under 112 1<sup>st</sup> paragraph as failing to comply with the written description requirement. Upon closer inspection, original claim 4 does indeed appear to contain information regarding "a plurality of first products scanned within a product category" and "a plurality of incentives redeemed". Therefore, the rejection above has been amended to remove these features. However, the rejection, while modified to remove portions, still remains because original claim 4, as well as the rest of the specification as a whole, is silent with regards to "past incentives refused".

6. Applicant argues "one skilled in the art would understand that a plurality of items first scanned within a product class on each shopping trip teaches that each product class may have a first scanned item or an item first scanned within a product class". However, the claim language states that a plurality of items are first scanned within a

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product class. Examiner reads this as a single product class with multiple products scanned "first". While Applicant's intention is clear from the arguments, the claim language still remains a problem, as it is still unclear how multiple products could be first scanned within a single product class.

7. Applicant argues "the manufacturer controlled incentive engines described by Deaton are incompatible with the data that would be provided by a wireless system as described by Sloane". However, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the above rejection, Examiner states "It would have been obvious to one having ordinary skill in the art at the time the invention was made to give the consumer a portable device for discount offers instead of supplying the offers at the point of sale when the customer is already checking out". Essentially, wireless technology is old and well-known, and the Sloane reference is used to show that incentive offers provided by the scanning of products using a wireless device is old and well-known. Since Deaton teaches Applicant's general process at a point-of-sale terminal, one skilled in the art would have found it obvious to combine well-known wireless technology (in which Sloane is used to merely give an example) with Deaton to make the technology mobile.



8. Applicant continues with "the references teach away from combination". The references would only be seen as combinable with the benefit of impermissible hindsight". Applicant appears to be merely invoking buzz-words such as "teach away" and "impermissible hindsight" without any real basis or reasoning. For a reference to teach away from combination with another, the reference must explicitly give a reason for avoiding a proposed combination. While Deaton has reasoning for performing operations at a point of sale, Deaton does not say that performing operations through a wireless device would not be possible. What is more perplexing, is that Applicant claims that hindsight reasoning is the only way one would combine Deaton and Sloane. Examiner is confused as to how, if 2 references supposedly teach away from each other, how they would be able to be combined under impermissible hindsight. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. Applicant argues "In Deaton, there is no distinction between products scanned and products purchased, as they are one and the same, therefore Deaton offers no inherent benefit to tracking the first product scanned". Examiner would like to point out that while products of Deaton are scanned, they are not purchased until money is

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exchanged. Further, the claim language does not require that any distinction needs to be made between products scanned and products purchased. The scanned products of Deaton are used to provide incentive offers. In any grouping of scanned products, there has to be a first scanned product. Therefore, this meets the claim language.

10. Applicant argues "Christensen does not assert the inference that the coupon as been rejected". However, just above this statement, Applicant posts a section of Christensen which states "if a given consumer uses **no** baby or child product coupons, such categories may be de-emphasized". Applicant does not address, in the claims or in the specification, what criteria needs to be met for an offer to be labeled as "refused", and one skilled in the art would understand that a coupon given, but not redeemed (as taught by Christensen) would be an example of a refusal of the offer provided by the coupon. Therefore, this teaching still appears to be appropriate. Applicant continues "Christensen teaches against the ability to infer coupon rejection in the event that a coupon is printed and then not redeemed, it is clear that in the event a coupon has not been printed and not redeemed that this would be an even more unreliable indicator of incentive rejection". Once again, Applicant does not define in the specification or the claims what criteria needs to be met for an offer to be labeled "refused". If an offer is not redeemed, the offer has been refused. A verbal or written response to an offer is not needed, only a determination that the consumer has bypassed the offer without a redemption,.

11. The applicant goes on to describe numerous scenarios in which the references are not combinable or compatible. For example, Applicant states "Integration of Sloane

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and Deaton would not work because the system described by Sloane provides coupons while shopping and Deaton instead provides them only after products have been purchased". This is inconsequential. Once again, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Similar reasoning may be used for Applicant's scenarios of "the time of data acquisition", "different systems for storing or acquiring the incentives", "different means of delivering incentives", and "different description of integration with traditional point of sale systems".

12. Applicant argues "Applicant's invention comprises more than starting with Deaton, adding the wireless scanning device as described in Sloane, and further adding the household ID as described by Christensen". This amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The claims as currently written are still subject to rejection as outlined above.

13. Examiner would like to reiterate that the entire specifications of the prior art are not being used. Deaton teaches specific elements, that when combined with specific elements of Sloane and Christensen, read over the claim language. The secondary references are merely supplied to show that the concept of wireless scanning and

delivery of incentives, as well as numerous ways of targeting incentives, were old and well-known at the time of Applicant's invention.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B./  
Examiner, Art Unit 3622

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622